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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,753	01/30/2002	Toshifumi Komatsu	2970.98US01	6971

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EXAMINER	
GILLIAM, BARBARA LEE	
ART UNIT	**PAPER NUMBER**
1752	

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/060,753	KOMATSU ET AL.	
	Examiner	Art Unit	
	Barbara L. Gilliam	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5,6,9,16,17,19 and 21-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5,6,9,16,17,19 and 21-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 2, 2006 has been entered.

2. The 112, 2nd paragraph rejection of claims 13-15 is withdrawn in light of the cancellation of said claims.

3. Claims 1-3, 5-6, 9, 16-17, 19, 21-25 are present.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-3, 5-6, 9, 16-17, 19, 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a. Claim 1 was amended by Applicant to require the calcium carbonate to be present in the ink receptive, radiation transmissive layer in an amount of at least 25 dry weight percent. There is insufficient support for this amendment. According to page 10 of the originally filed specification, the inorganic particulates (e.g. calcium carbonate) are present in an amount "from about 5 to 10 percent by weight, less than 10 percent, typically less than 20 percent and usually less than 40 percent of the ink receptive material." The examples do not support the claimed range either.

b. Claims 2-3, 5-6, 9, 16-17, 19, 21 and 22 are dependent on independent claim 1.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear if each of the photosensitive layers, the first tack photosensitive layer and the second substantially less tacky photosensitive layer, contain the pressure sensitive adhesive compound, the polymeric photosensitive resin and the polyvinyl acetate described in independent claim 1.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-3, 5-6, 9, 16-17, 19, 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoogmartens et al. (US 5,922,506) in view of Asano et al. (US 6,106,992).

a. In US 5,922,506, Hoogmartens et al. teach a negative-working photosensitive imaging element comprising on a hydrophilic surface of a support in the order given, a hydrophobic photopolymerization layer contiguous to the hydrophilic surface of the support and comprising at least part of at least one unsaturated compound, a hydrophobic photosensitive layer contiguous to the polymerizable layer and comprising at least part of at least one hydrophobic thermoplastic polymer and at least one photoinitiator and optionally a receptor layer (claim 1). The thermoplastic polymers are used in an amount of at least 50% by weight and examples thereof include polyvinyl acetate (column 6, lines 50-51; column 8, lines 47-54). Agents to improve the wetting an/or adjust the adhesion of the photopolymerizable composition may be added (column 7, lines 37-43 & column 8, lines 42-46). The support can comprise a polyethylene layer (column 10, lines 44-54) and comprise one or more hydrophilic layers such as layers of hardened polyvinyl alcohol (column 10, lines 25-36). The support meets the present limitations for the carrier layer and the hydrophilic layer coated thereon meets the present limitations for the membrane layer. The imaging element of Hoogmartens et al. may comprise a temporary protective layer on top of the photosensitive layer, which can comprise polyvinyl alcohol. The temporary layer can be

removed before or after the photoexposure step (column 10, lines 62-67). Preferably the imaging element either comprises a receptor layer or a transfer layer and a receptor layer wherein the transfer layer is between the photosensitive composition and the receptor layer. Suitable receptor layers include transparent organic resins (column 11, lines 1-25). The temporary protective layer and the receptor layer meet the present limitations for the ink-receptive, radiation transmissive layer. Additionally the temporary protective layer meets the present limitations for the printable cover sheet. Hoogmartens et al. do not teach organic or inorganic particles in the temporary protective layer or the receptor layer however, based on the teachings of Asano et al. (column 14, lines 55-67 & column 21, lines 33-46) it would have been obvious to incorporate fillers such as calcium carbonate into either layer to reduce to cost and increase handleability. Preferably, the fillers are used in an amount of 10 to 500 parts by weight (col. 14, lines 64-67). The imaging element is then image-wise exposed to actinic radiation (Hoogmartens et al; column 13, line 46 – column 14, line 58).

Response to Arguments

10. Applicant's arguments filed February 2, 2006 has been fully considered but are not persuasive. Applicant's arguments are essentially the same as those presented in the Response filed December 20, 2004.

a. Applicant argued that one of ordinary skill would not combine the teachings of Asano with Hoogmartens because Asano is directed to a positive working film and Hoogmartens is directed to a negative working film. Applicant further argues there is no teaching for an ink receptive layer in Asano and that calcium carbonate is

only incorporated into the interior layers and not present in a layer near the exterior surface of the multilayer film. The Examiner relied upon the teachings of Asano for the sole purpose to show it would be obvious to incorporate a filler, such as calcium carbonate, into the temporary protective layer. According to Asano, it would have been obvious to incorporate such fillers in a photosensitive resin composition to reduce cost and to improve handleability (column 14, lines 55-67 & column 21, lines 33-46). It is the Examiner's position that it would have been obvious to incorporate the filler in the receptor layer or the temporary cover sheet for the same reasons.

b. In response to Applicant's argument that there is nothing in Asano that indicates beneficial properties of the calcium carbonate or useful improvements in performance once can obtain from the incorporation of the calcium carbonate, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Again, it would have been obvious to incorporate fillers such as calcium carbonate in a photosensitive resin composition to reduce cost and to improve handleability (column 14, lines 55-67 & column 21, lines 33-46).

c. The Examiner maintains the claims are obvious in view of Hoogmartens et al. as modified by Asano et al.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg
March 14, 2006